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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/921,803	08/03/2001	Hugh James O'donnell	OT-4812	8340

26584 7590 04/28/2003

OTIS ELEVATOR COMPANY
INTELLECTUAL PROPERTY DEPARTMENT
10 FARM SPRINGS
FARMINGTON, CT 06032

EXAMINER

TRAN, THUY VAN

ART UNIT PAPER NUMBER

3652

DATE MAILED: 04/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/921,803

Applicant(s)
O'Donnell et al.

Examiner
Thuy V. Tran

Art Unit
3652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 22, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above, claim(s) 1-5 and 9-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6-8 and 13-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 & 6 6) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Claims 1-5 and 9-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 4.
2. Applicant's election with traverse of Group II, claims 6-8 and 13-15 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the two Inventions would require the same search. This is not found persuasive because these inventions are distinct and have acquired a separate status in the art as shown by their different classification.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

3. Claims 13 and 15 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Independent claim 6 has already set forth a method of making an elevator rope assembly.

Same problem occurs in claim 15 as well.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second, third and forth paragraphs of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

A claim may be written in independent or, if the nature of the case admits, in dependent or multiple dependent form.

Subject to the following paragraph, a claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.

5. Claims 13-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 13, it is unclear whether the claim is directed toward a method of making a product or a final product since no positive limitation has set forth in the claim. Same problem occurs in claim 15 as well.

6. Claims 13-15 are rejected under 35 U.S.C. 112, fourth paragraph, as being indefinite for failing to specify a further limitation of the subject matter of a previous claim.

Claim 13 fails to further limiting the subject matter of the previous claim. Same problem occurs in claim 15 as well.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 6, 7, 13 and 14 (as best understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Thomson 4,550,559 (IDS).

Thomson '559 discloses a method of making an elevator rope assembly comprising the steps of arranging a plurality of elongate load carrying members 11 (col. 2, lines 10-13) in a selected arrangement, coating the load carrying members with thermal polyurethane that does not contain wax (col. 2, lines 36-45).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6-8 and 13-15 (as best understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over DeAngelis 6,392,551 in view of Graff 3,829,531 or Scudder 3,274,322.

DeAngelis '551 discloses a method of making an elevator rope assembly comprising steps of arranging a plurality of load carrying members 2-4, fig. 1, coating the plurality of load carrying members with a thermal polyurethane coating 8. DeAngelis does not mention a release agent applying to the mold.

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Graff '531 and Scudder '322 separately shows that when coating a product with poly/urethane, apply release agent to the mold would easily strip the coating from the mold.

It would have been obvious to one having ordinary skill in the rope making art to have applied release agent to the mold of DeAngelis in order to strip the urethane coating from the mold as well known in the rope making art.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Each of the cited references separately discloses either a method of making an elevator rope assembly and/or an elevator rope assembly.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy v. Tran whose telephone number is (703) 308-2558.

Thuy Tran
4/21/03

TVT

April 21, 2003